



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/669,594 | 09/26/2000 | Prasad Raje | 004426.P001 | 5001 |

7590 05/09/2003

Blakley Sokoloff Taylor & Zafman LLP
12400 Wilshire Boulevard Seventh Floor
Los Angeles, CA 90025

EXAMINER

BASHORE, WILLIAM L

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2176

DATE MAILED: 05/09/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/669,594

Applicant(s)

RAJE, PRASAD

Examiner

William L. Bashore

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 126-142 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 126-142 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: Amendment, filed 2/14/2003, to the original application filed 9/26/2000, with provisional filing date of 9/30/1999. IDS filed 5/4/2001.
2. The rejection of claims 102-107, 110-115, 118-123 under 35 U.S.C. 103(a) as being unpatentable over Wang, has been withdrawn as necessitated by amendment.
3. The rejection of claims 108-109, 116-117, 124-125 under 35 U.S.C. 103(a) as being unpatentable over Wang and Brandt has been withdrawn as necessitated by amendment.
4. Claims 126-142 are pending. Claims 102-125 have been canceled. Claims 126-142 have been added. Claims 126, 132, 137 are independent claims.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 126-142 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holt et al. (hereinafter Holt), U.S. Patent No. 5,557,723 issued September 1996, in view of Hitchcock et al. (hereinafter Hitchcock), U.S. Patent No. 6,460,042 issued October 2002.

In regard to independent claim 126, Holt teaches a method of customizing and transmission of forms between users via an electronic mail system. A form is developed (authored) by a user, said form

Art Unit: 2176

containing input fields (Holt Abstract, column 3 lines 5-15, column 4 lines 13-16, Figure 3; compare with claim 126 “*A method comprising: receiving a form authored by a user...one or more input fields*”).

The limitation of a form authoring language would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Holt, because Holt teaches customization/creation of forms (Holt Abstract, Figure 3). Since it is known that input form creation typically involves a language tailored to such creation (i.e. Pearl), it would have been obvious to the skilled artisan to use such a language providing Holt the advantages that a specific authoring language provides (compare with claim 126 “*a form authoring language*”).

Holt does not specifically teach parsing a form to identify fields. However, Hitchcock teaches a universal forms engine for form customization of on-line forms (Hitchcock Abstract). Hitchcock teaches an application description file which is parsed to build a corresponding HTML form (Hitchcock column 10 lines 42-46; compare with claim 126 “*parsing the received form to identify the input fields contained in the received form*”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Hitchcock’s parsing method to Holt, providing Holt the benefit of parsing a form to accurately identify input field placement and function.

Holt teaches a user specifying field layout and field behavior of a custom form (Holt column 2 lines 1-5). Holt also teaches a final customized graphical input form displayed to a user within a graphical user interface (GUI), the input field size dependent upon the GUI size (Holt Figure 3). Although the display of Holt Figure 3 is of finalized form, the input fields of Holt Figure 3 are by nature graphical, therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use said graphical depiction in the development mode (for specifying said field behavior), providing Holt the benefit of graphical depictions for previewing forms (compare with claim 126 “*providing a graphical user interface to the user to allow...on the identified input fields*”).

Holt teaches a customized input form (Holt Figure 3) in which a user can specify field layout and behavior of input fields (Holt column 2 lines 3-5). Holt teaches a “Form Control Procedure” (FCP) to

Art Unit: 2176

implement user defined processing of said form (Holt column 2 lines 45-53). Since input form behaviors are generally implemented by code instructions, user customization results in automatic customization of the code constructs so as to carry out the user's alterations (compare with claim 126 "*automatically generating a program code to carry out the actions identified by the user.*").

In regard to dependent claims 127, 128, Holt teaches e-mail forms (Holt Title, Figure 3). Holt does not specifically teach HTML, or CGI. However, Hitchcock teaches form customization using HTML, as well as CGI (Hitchcock column 4 lines 4-10, 30-35). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Hitchcock to Holt, providing Holt the benefit of a popular language and program suited for the addition and processing of input forms.

In regard to dependent claims 129, 130, claims 129, 130 incorporate substantially similar subject matter as claimed in claim 126, and in further view of the following, is rejected along the same rationale.

Holt teaches a custom form containing a form control procedure (Holt column 25-29). Holt also teaches receiving a form with input data (Holt Abstract). Holt's form acts upon the input data by detecting whether said data exists in form fields, enabling/disabling fields accordingly (Holt column 5 lines 26-33).

In regard to dependent claim 131, Holt teaches an indication that a Form Control Procedure (FPC) will be called periodically to ensure consistency of a form customized to update the time (Holt column 5 lines 12-15).

Generating an alert if the program code is not consistent with the form would have been obvious to one of ordinary skill in the art at the time of the invention, because Holt teaches periodic updating of the time on a form using generated FPC code (Holt column 5 lines 12-15). Since display of the wrong time typically conveys an implicit message to the user that something is wrong (i.e. update via FCP

Art Unit: 2176

failed), the use of an alert in cases of inconsistency would have been obvious to the skilled artisan, providing Holt the benefit of increased time accuracy.

In regard to independent claim 132, claim 132 reflects the system comprising computer readable instructions used for implementing the methods as claimed in claim 126, and is rejected along the same rationale.

In regard to dependent claim 133, Holt teaches customization of electronic forms using e-mail, which typically involve a plurality of processors (Holt Title, Abstract).

In regard to dependent claims 134, 135, 136, claims 134, 135, 136 132 reflect the system comprising computer readable instructions used for implementing the methods as claimed in claims 127, 128, 131 respectively, and are rejected along the same rationale.

In regard to claims 137-142, claims 137-142 reflect the computer program product comprising computer readable instructions used for implementing the methods as claimed in claims 126-131 respectively, and are rejected along the same rationale.

7. **Prior art made of record and not relied upon is considered pertinent to disclosure.**

| | | | |
|--------|---------------------------|--------|---------|
| Karnik | U.S. Patent No. 5,404,294 | issued | 04-1995 |
| Texier | U.S. Patent No. 5,119,476 | issued | 06-1992 |

Response to Arguments

8. Applicant's arguments with respect to newly added claims 126-142 have been considered but are moot in view of the new ground(s) of rejection. It is to be noted that Applicant's newly added claims

Art Unit: 2176

change the scope of the claimed invention when read as a whole (i.e. an authoring language, graphical user interface, etc.).

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Bashore whose telephone number is **(703) 308-5807**. The examiner can normally be reached on Monday through Friday from 11:30 AM to 8:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on **(703) 308-5186**.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(703) 305-3900**.

Art Unit: 2176

11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 746-7239 (for formal communications intended for entry)

or:

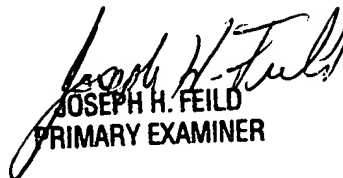
(703) 746-7240 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

or:

(703) 746-7238 (for after-final communications)

**Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA, Fourth Floor (Receptionist).**

William L. Bashore
May 02, 2003


JOSEPH H. FEILD
PRIMARY EXAMINER